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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,101	06/15/2001	Jack B. Strong	21495-05944	7948

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EXAMINER

NGUYEN, PHUOC H

ART UNIT PAPER NUMBER

2143

DATE MAILED: 01/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,101

Applicant(s)

STRONG ET AL.

Examiner

Phuoc H. Nguyen

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-12 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-12, and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Request for Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.
2. Amendment received on October 12, 2005 has been entered into record.
3. Claims 2-12 and 21 remain pending.

Response to Amendment

4. This office action is in response to the applicants Amendment filed on October 12, 2005. Claim 2 has been amended, claims 13-20 have been cancelled, and claim 21 has been added. Claims 2-12 and 21 are presented for further consideration and examination.
5. The amendment filed on October 12, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material to claims 2 and 21 which is not clearly supported by the original disclosure is as follows “... *after sending the changed data, receiving second data, where the first data and the second data are both part of the web page.*”

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The analysis under 35 U.S.C. 112, first paragraph, requires that the scope of protection sought be supported by the specification disclosure. The pertinent inquiries include determining (1) whether the subject matter defined in the claims is described in the specification and (2) whether the specification disclosure as a whole is to enable one skilled in the art to make and use the claimed invention.

(1) Claims 2 and 21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The "invention" for the purpose of the first paragraph analysis is defined by the claims. The description requirement is simply that the claimed subject matter must be described in the specification. The function of the description requirement is to ensure that the applicant had possession of the invention on the filing date of the application. The application need not describe the claim limitations exactly, but must be sufficiently clear for one of ordinary skill in the art to recognize that the applicant's invention encompasses the recited limitations. The description requirement is not met if the application does not expressly or inherently disclose the claimed invention.

Specification does not explicitly describe nor is sufficiently clear for one of ordinary skill in art to recognize the following steps as recited in claims 2 and 21:

- *after sending the changed data, receiving second data, where the first data and the second data are both part of the web page.*

(2) Claims 2 and 21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The enablement requirement necessitates a determination that the disclosure contains sufficient teaching regarding the subject matter claimed as to enable one skilled in the pertinent art to make and use the claimed invention. In essence, the scope of enablement provided to one ordinarily skilled in the art by the disclosure must be commensurate with the scope of protection sought by the claims.

Currently, the most prevalent standard for measuring sufficient enablement to meet the requirements of 112 is that of "undue experimentation". The test is whether, at the time of the invention, there was sufficient working procedure for one skilled in the art to practice the claimed invention without undue experimentation. It is important to note that the test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. A skilled artisan is given sufficient direction or guidance in the disclosure. Moreover, the experimentation required, in addition to not being undue, must not require ingenuity beyond that expect of one of ordinary skill in the art.

Undue experimentation and ingenuity would be required beyond one ordinarily skilled in the art to practice the following steps as recited in claims 2 and 21:

- *after sending the changed data, receiving second data, where the first data and the second data are both part of the web page.*

Undue experimentation would be needed to make *after sending the changed data, receiving second data, where the first data and the second data are both part of the web page.*

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 3-10 recites the limitation "the received data". There is insufficient antecedent basis for this limitation in the claim. Appropriated correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 2-12, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Jamtgaard et al (Hereafter, Jamtgaard) U.S. Pat. No. 6,430,624.

11. Regarding claims 2, 21, Jamtgaard discloses a method and system for providing data over an electronic network to a wireless computing device having a browsing program (Figure 2) comprising: receiving first data that is part of a web page, the first data having a first display

format (col. 7, 2 paragraph); changing the first data having a first display format to a second display format, wherein the second display format is capable of being displayed by the browsing program (e.g. translation server receive the content information and translated it to another format that compatible with appliance devices) (col. 7, lines 22-25)); sending the changed data having the second display format to a display of the wireless device; and after sending the changed data, receiving second data, wherein the first data and second data are both part of the web page (Figures 15 16 and 17; col. 2 lines 12-17 and col. 4 lines 21-32; col. 7, lines 42-44; col. 8 lines 27-54; col. 13 lines 19-44; and col. 17 last paragraph through col. 18 1st paragraph).

12. Regarding claim 3, Jamtgaard further discloses compressing (inherently) the received data (col. 2 lines 60 through col. 3, lines 8).

13. Regarding claim 4, Jamtgaard further discloses stripping out a portion of the received data (col. 7, lines 13- 1 8).

14. Regarding claims 5-8, Jamtgaard further discloses converting the received data from HTML to WML HDML PQA or M'ITML (Figures 1 and 2; col. 2 lines 50-59; and col. 4 2nd paragraph).

15. Regarding claim 9, Jamtgaard further discloses reformatting the received data (col. 4 last paragraph through col. 5 1st paragraph).

16. Regarding claim 10, Jamtgaard further discloses assessing a type of the received data; and changing the format in accordance with the type (col. 7, 2nd and 3rd paragraphs).

17. Regarding claim 11, Jamtgaard further discloses assessing a type of the browsing program, and changing the format in accordance with the type (col. 7, 2nd paragraph).

18. Regarding claim 12, Jamtgaard further discloses assessing a size of the display on the wireless computing device, assessing browsing program and device preferences set by the user, and changing the format in accordance with the size and preferences (col. 7, lines 31-66).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuoc H. Nguyen whose telephone number is 571-272-3919. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Phuoc H Nguyen
Examiner
Art Unit 2143

December 30, 2005



**JEFFREY PWU
PRIMARY EXAMINEE**